

REMARKS

Claims 9-18 are pending in the application. Claims 9-14 are rejected. The existence of claims 15-18 is not acknowledged in the Office Action. The title of the present application and the abstract are objected to.

The present application is a divisional application. A preliminary amendment accompanied the present application when it was filed in which claims 1-8 were canceled, claim 14 was amended to remove multiple dependencies, and claims 15-18 were added to restore the combinations of claim features that were lost by the amendment to claim 14.

The Office Action acknowledges the cancellation of claims 1-8 but does not acknowledge the existence of claims 15-18 and apparently does not acknowledge the amendment to claim 14.

Specification

The title of the present application is objected to for not being descriptive. In response, Applicants amend the title as suggested in the Office Action.

The abstract is objected to. Applicant amends the abstract as shown above and requests reconsideration.

Claim Rejections Under § 112

Claim 10 is rejected under 35 U.S.C. § 112, second paragraph. In response, Applicant amends claim 10 as shown above and requests reconsideration.

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph. The Office Action indicates it is not clear which of claims 9-13 that claim 14 depends on.

Applicants respectfully traverse this rejection for at least two reasons. First, claim 14 was amended to be dependent on only claim 9. Second, even if claim 14 had not been amended, the unamended claim was a proper multiple dependent claim.

Claim Rejections Under § 103

Claims 9 and 11-14 are rejected under 35 U.S.C. § 103 for being unpatentable over Admitted Prior Art (APA) as shown in Figs. 4A-4C and discussed on pages 1-4 of the specification.

Independent claim 9, which is amended to remove an unnecessary limitation and to correct an improper term, reads as follows (letters are added to features of the claim for convenient reference in the following discussion):

9. A method of manufacturing an electronic component comprising a contact having a terminal section for brazing and a contact section, said method comprising the steps of:

(a) constructing a base member of said contact made of a material which is poorly wettable to a weld brazing material;

(b) forming on said base member a finish plating layer made of a material which is highly wettable to the weld brazing material; and

(c) forming an exposed region of said poorly wettable base member by selectively removing a portion of said highly wettable finish plating layer by means of a mechanical processing technique,

(d) said exposed region of said highly wettable base member serving as an arresting region for arresting creeping-up of said weld brazing material.

The Office Action indicates the APA discloses all that is claimed except step (c); that this step is inherent; and furthermore step (c) would have been an obvious design choice “since applicant has not disclosed that the process steps as described above are critical, patentably distinguishing features and it appears that the invention would perform equally well with the prior art teaching as discussed by APA’s on page 3, lines 17-22.”

Applicant respectfully disagrees. It is interesting to note that the Office Action refers to the prior art illustrated in Figs. 4a-4c. These figures illustrate examples of a prior art component that does not have any exposed region of poorly wettable material and therefore, cannot provide any teaching or even a hint for step (c) or feature (d) of claim 9. The prior art discussed on pages 1-4 of the specification includes two manufacturing methods.

- (1) A method described on page 2, lines 9-27, forms an oxide film region 113 to arrest the creep of a brazing material. A component formed by this process is shown in Figs. 1-2. There is no disclosure or suggestion for forming an exposed region of any type of material including the claimed poorly wettable material.
- (2) Another method forms a nickel plating layer over the contact, then forms a coating of gold in two sections over the nickel plating layer with a predetermined spacing between the two sections, and then forms an arresting regions by oxidizing the nickel plating layer that is exposed between the two sections. A component formed by this process is shown in Figs. 3a-3c. This differs from what is claimed in at least two respects: (a) the finish plating layer is not selectively removed, and (b) the nickel plating material that is exposed for oxidization is not a poorly wettable material.

With regard to the assertion in the Office Action that step (c) is inherent in APA, Applicants are unable to see anything inherent in these two methods or in any of the components illustrated in Figs. 1-4 that suggests or constitutes a removal of the highly wettable finish plating layer as recited in step (c). Applicants respectfully submit this processing step is not inherent. If the Examiner is still of the opinion this step is inherent, Applicants respectfully request a clear explanation that shows its inherency.

With regard to the assertion in the Office Action that step (c) would have been an obvious design choice, Applicants respectfully disagree. Applicants believe it should be very clear that there is no disclosure or suggestion for the removal recited in step (c). Both manufacturing methods that are described in the APA form an arresting region by oxidization of an already exposed layer. There is no need or obvious reason to selectively remove a finished plating layer as claimed.

The Office Action alleges the motivation would have been obvious because "applicant has not disclosed that the process steps as described above are critical, patentably distinguishing features and it appears that the invention would perform equally well with the prior art teaching as discussed by APA's on page 3, lines 17-22." With all due respect, this alleged motivation has no basis in law and it is not sufficient to make out a *prima facie* case of obviousness. Furthermore, whether the claimed method of manufacture is superior to known techniques is irrelevant to an assessment of its patentability.

All remaining claims including the newly added claims are dependent on claim 9.

CONCLUSION

Applicants amend the application and request reconsideration in view of the discussion set forth above.

Respectfully submitted,



David N. Lathrop
Reg. No. 34,655
601 California St., Suite 1111
San Francisco, CA 94108-2805
Telephone: (415) 989-8080
Facsimile: (415) 989-0910

Enc. Check for \$120

Certificate of Mailing Under 37 CFR 1.8

I certify that this Response to Office Action and any enclosed materials are being deposited with the United States Postal Service on February 9, 2005 with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450..



David N. Lathrop